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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,642	04/27/2001	Dan Kikinis	04688P012	1583

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EXAMINER
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USTARIS, JOSEPH G

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/844,642

Applicant(s)

KIKINIS, DAN

Examiner

Joseph G. Ustaris

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☒ Claim(s) 13-16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/29/01, 7/17/01, 8/30/01, 1/31/02.</u>                                   | 6) <input type="checkbox"/> Other: ____                                     |

## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statements (IDS) submitted were on 29 May 2001, 17 July 2001, 30 August 2001, and 31 January 2002. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 11, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Curran et al. (US006753849B1).

Curran et al. (Curran) discloses a system for providing mouse-functions in conjunction with a display screen (See column 1 line 55 – column 2 line 5). The system includes “a television having a screen” (See Fig. 5, element 15 and 115), and “a set-top box coupled to the television” (See Fig. 5, element 12; column 8 line 62 – column 9 line 21). The “set-top box” includes “a receiver” (See Fig. 10, element 221; column 8 lines

62-67), "a processor coupled to the receiver to receive signals as received and translated by the receiver" (See Fig. 10, element 207; column 8 line 62 – column 9 line 4), and "a video controller coupled to the processor and coupled to the television, the video controller to receive commands from the processor and translate those commands to signals, the signals sent to the television to control the screen" (See Fig. 10, element 223 and 225; column 8 line 62 – column 9 line 21). The system further includes "a remote control" (See Fig. 1) that has "a housing having an aperture" (See Figs. 1 and 2), "a sensor within the housing, coupled to the housing at a location within an optical path from the aperture" (See Fig. 2, element 17, 20, 24, 25; column 2 lines 61-67), "a microcontroller electrically coupled to the sensor and coupled to the housing" (See Fig. 9, element 86), and "a transmitter electrically coupled to the microcontroller and coupled to the housing" (See Fig. 2, element 22 and Figs. 7-9).

Claim 11 contains the limitations of claim 1 (wherein the remote control is part of the system) and is analyzed as previously discussed with respect to that claim.

Regarding claim 12, the "transmitter is an infrared transmitter" (See column 3 lines 12-16).

Claims 2-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Marsh et al. (US005999167A).

Regarding claim 2, Marsh et al. (Marsh) discloses a "point and click" cursor control device that "manipulates a cursor on a tv screen utilizing a wireless remote control" (See Fig. 3). The system "detects a location on the screen pointed to by the

remote control" and "transmits the location to a set-top box" (See Fig. 3; column 7 lines 34-61).

Regarding claim 3, the system "displays a cursor at the location" (See column 1 lines 36-48 and column 7 lines 35-38).

Regarding claim 4, the system allows the user to "move the remote control to a position pointing to a new location on the screen, detect the new location, and transmits the new location to the set-top box" (See column 1 lines 25-48).

Claim 5 contains the limitations of claims 2 and 4 and is analyzed as previously discussed with respect to those claims.

Regarding claim 6, the system "displays the cursor at the new location" pointed to by the user (See column 1 lines 25-48 and column 7 lines 34-61).

Claim 7 contains the limitations of claim 2 and is analyzed as previously discussed with respect to that claim. Furthermore, Marsh discloses a mouse button or "receiving a grab of the cursor, the cursor pointed to by the wireless remote control" (See column 7 lines 34-40). The remote control "transmits an indication of the grab to a set-top box coupled to the TV screen" (See column 7 lines 34-43). The system "receives an indication of motion of the remote control" and "transmits the indication of motion of the remote control to the set-top box" (See column 1 lines 25-48 and column 7 lines 34-61).

Regarding claim 8, the system "displays the cursor at a location determined based on the indication of motion of the remote control" (See column 1 lines 25-48 and column 7 lines 34-61).

Regarding claim 9, the indication of motion is an indication that a section of the XYZ plane or "a sector boundary" has been crossed (See Figs. 5a-5g).

Regarding claim 10, "the indication of motion is an indication of a location pointed to by the remote control different from a location of the cursor when the indication of the grab was transmitted" (See column 1 lines 25-48 and column 7 lines 34 – column 8 line 10).

### ***Allowable Subject Matter***

3. Claims 13-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claims 13-16, the prior art of record fails to show or fairly suggest placing a "semi-mirror" within the optical path between the "aperture and the sensor" allowing a "light source" to emit a light beam at the "semi-mirror" which, upon reflection, follows the optical path to the aperture.

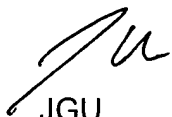
### ***Conclusion***


4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please take note of Fan (US005926168A) for their similar method of control a cursor on a screen.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph G. Ustaris whose telephone number is 571-272-7383. The examiner can normally be reached on M-F 7:30-5PM; Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on 571-272-7950. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
JGU  
May 9, 2005

  
VIVEK SRIVASTAVA  
PRIMARY EXAMINER